REMARKS

1. Status of the Claims:

Previously, Applicant responded to the Examiner's final office action mailed 6-25-2008 with an after final amendment filed 8-21-2008 amending the claims. The amendments were entered as stated in the advisory action mailed 1-13-2009. Currently, claims 1-12, and 21-28 are rejected and pending in the present application.

2. Rejection of claims 1, 21 and 26-28 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention should be withdrawn.

In the advisory action mailed 1-13-2009, examiner stated that "Applicant's amendment appears to overcome the 112, second paragraph, rejection ..." *See* Advisory Action mailed 1-13-2009, section 11. Therefore, applicant requests that the rejection under 112, second paragraph be withdrawn.

3. Rejection of claims 1, 27 and 28 under 35 USC 102(e) as being anticipated by US Patent No. 6,640,211 to Holden should be withdrawn.

A rejection under 35 USC 102 can be overcome by persuasively arguing that the claims are patentably distinguishable from the prior art. *See* MPEP 706.02(b). Here, Applicant argues that claims 1, 27 and 28 are patentably distinguishable over US Patent No. 6,640,211 Holden ("the Holden '211 patent").

a. Claim 1 is patentably distinct with respect to the Holden '211 patent.

Examiner rejected claims 1, 27 and 28 under 35 USC 102(e) as being anticipated by the Holden '211 patent for the same reasons indicated in the Board Decision of 3/6/06. *See* Office action mailed 6/25/2008, page 3, section 3. The Board demonstrates anticipation of claims 1, 27 and 28 by Holden in the chart of page 16 of the Board's Decision. The Board argues that the limitation of claim 1 of "determining electronically a bioinformatic value associated with a user," is anticipated in Holden "Running tests based on the stored profile," col. 1, lines 49-54. However, Holden does not disclose this limitation.

Holden discloses a medical practitioner authorization to have access by the patient and confirmed by the access control system can access the profile that is stored and can *run tests* based on the profile as stored in the database; for example, such a test can be run to determine the presence or absence of certain makers. Holden '211, col. 1, lines 49-54.

In contrast, Applicant discloses in specification a description of the element of claim 1, generally in a secure network configuration preferably according to the present automated transaction process and/or system, one or more personal or unique bioinformatic value, genetic term, DNA (deoxyribonucleic acid) sequence, folding structure, or subset thereof, or other biologically, hereditary, or genetically identifiable or classifiable data associated with one or more user, participant, client, or other designated person or associated being is determined, provided, accessed, generated, calculated, processed, computed, or otherwise obtained. *See* Specification, page 5-6.

Furthermore, Applicant discloses, preferred bioinformatic value or genetic term is accessed, provided or generated as digital or alphanumeric data structure, including one

or more user identifier field, and genetic sequence subset, mask, screen, or, filter field, effectively such that user reference sequence is processable securely for authorized transaction using sequence subset or genetic mask to qualify or otherwise evaluate participating user. Identifier may include partial or complete user social security number or other unique, random, or signature code. . *See* Specification, page 6.

In summary, the Holden '211 patent discloses running tests on a genetic profile in a database. In contrast, Applicant claims "determining electronically a bioinformatic value associated with a user." Therefore, the limitation of claim 1 is patentably distinct with respect to the prior art and is not anticipated in Holden.

b. Claims 1, 27 and 28 are patentably distinct with respect to the Holden '211 patent and in further view of Examiner's reasons.

Examiner states that claims 1, 27, and 28 have been amended to now recite "... and protein folding structure" as per this limitation, Holden teaches that its profiles by genetic banking and testing services that are provided, and can included genotyping and bioinformatic profiling of general and or specific genetic marker panels (see: column 3, lines 31-27.) *See* Office action, mailed 6-25-2008, page 3, section 3.

Applicant respectfully disagrees, Holden discloses that a physical genetic sample is processed by the testing system and that such processing is used to determine risks of many diseases including without limitation, cancer, Huntington's Disease, Alzheimer's Disease, and hypertension. Therefore, Holden discloses that genetic information is processed to test a sample for a variety of diseases.

In contrast, Applicant's claims "Automated transaction method comprising the steps of: determining electronically a bioinformatic value associated with a user; and

transacting via a processor with the user according to the bioinformatic value, wherein the bioinformatic value is automatically determined when or after the user permits access to a voluntarily-selected portion of his or her personal genetic nucleotide and related *protein folding structure* profile, such accessible portion being associated or used with evaluating the user transaction via said processor, an other portion of such genetic and related protein profile being not voluntarily-selected by the user and thereby inaccessible for evaluating the user transaction," *see* Claim 1; "permitting by a user access to a voluntarily-selected portion of a personal genetic nucleotide and related *protein folding structure* profile of the user, such accessible portion being used to determine electronically a bioinformatic value associated with the user, an other portion of such genetic nucleotide and related *protein folding structure* profile being not voluntarily-selected by the user and thereby inaccessible for determining the bioinformatic value; and transacting via a processor by the user according to the determined bioinformatic value," s*ee* Claim 27; "determining electronically by a care-giver a bioinformatic value associated with a user, the user permitting access to a voluntarily-selected portion of a personal genetic nucleotide and related *protein folding structure* profile of the user, such accessible portion being used to determine the bioinformatic value associated with the user, an other portion of such genetic nucleotide and related *protein folding structure* profile being not voluntarily-selected by the user and thereby inaccessible for determining the bioinformatic value; and transacting via a processor with the user a healthcare service according to the determined bioinformatic value, s*ee* Claim 28.

In summary, the Holden '211 patent discloses processing a physical sample by genotyping, and bioinformatic profiling. In contrast, Applicant claims permitting by a

user access to a voluntarily-selected portion of a personal genetic nucleotide and related *protein folding structure* profile. Therefore, the limitation of claims 1, 27 and 28 are patentably distinct with respect to the prior art and is not anticipated in Holden.

4. Rejection of claims 10-12, 21 and 23-26 under 35 USC 103(a) as being unpatentable over US Patent No. 6,640,211 to Holden should be withdrawn.

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2142. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR,* 550 U.S. at ___ , 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

a. Examiner did not provide analysis supporting an obviousness-type rejection of claims 21 and 26 over Holden.

Applicant herein argues that Examiner did not provide explicit analysis supporting an obviousness-type rejection under 103. Examiner has stated that as per the limitation of claims 21 and 26 of "... and protein folding structure," Holden teaches that its profiles by genetic banking and testing services are provided, and can include genotyping and bioinformatic profiling of general and or specific genetic marker panels (see: column 3,

line 31-47). However, this statement by examiner is merely a conclusory statement. Furthermore, examiner has not articulated any reasoning with some rational underpinning to support the legal conclusion of obviousness.

In particular respect, Applicant does not know why the limitation of "... and protein folding structure," is obvious over the relevant sections of Holden. There is no articulated reasoning in examiner's response to indicate why the limitation of "... and protein folding structure," is obvious over Holden's profiles by genetic banking and testing services. There is no articulated reasoning in examiner's response to indicate why the limitation of "... and protein folding structure," is obvious over Holden's genotyping and bioinformatic profiling. Therefore, the rejection under 35 USC 103 should be withdrawn.

b. Examiner did not provide analysis supporting an obviousness-type rejection of claims 2-4, 6-9 and 22 over Holden in view of Asch.

Applicant does not know why the claims 2-4, 6-9, and 22 are obvious over the Holden in view of *Genetic Tests: Evolving Policy Questions*, Asch. Examiner has not provided any articulated reasoning. Therefore, the rejection under 35 USC 103 should be withdrawn.

c. Examiner did not provide analysis supporting an obviousness-type rejection of claim 5 over Holden in view of O'Flaherty.

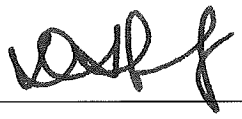
Similarly, applicant does not know why claim 5 is obvious over Holden in view of US Patent No. 6,275,824 to O'Flaherty. Examiner has not provided any articulated reasoning. Therefore, the rejection under 35 USC 103 should be withdrawn.

CONCLUSION

For the forgoing reasons, Applicant respectfully requests that a timely notice of allowance be granted in the present application.

Respectfully submitted,

Date 01/20/2009



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